

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
September 21, 2004

Mailed: October 28, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Deborah Heart and Lung Center
v.
Deborah Strange-Browne Inflammatory Breast Cancer Foundation

Opposition No. 91154019
to application Serial No. 76226481
filed on March 19, 2001

John P. Blasko of Fox Rothschild LLP for Deborah Heart and Lung Center.

Marc N. Blumenthal of Law Office of Marc N. Blumenthal for Deborah Strange-Browne Inflammatory Breast Cancer Foundation.

Before Seeherman, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Deborah Heart and Lung Center (a not-for-profit New Jersey corporation) has opposed the application of Deborah Strange-Browne Inflammatory Breast Cancer Foundation (a not-for-profit Illinois corporation) to register on the Principal Register the mark shown below



for "charitable fundraising services for inflammatory breast cancer research and raising money for community health awareness programs" in International Class 36, and "education services, namely, community health awareness programs in the nature of seminars and classes" in International Class 41.¹

Opposer asserts as grounds for opposition that it owns five registered marks, all consisting of or containing the word DEBORAH, and used in connection with charitable fundraising services, educational services, and/or healthcare services; that opposer's use of its marks is prior to applicant's filing of its application; and that applicant's mark, when used in connection with its services, so resembles opposer's previously used and registered marks, as to be likely to cause confusion, mistake, or deception.

Opposer's five pleaded registrations are identified below:

¹ Application Serial No. 76226481, filed March 19, 2001, based on applicant's assertion of a bona fide intention to use the mark in commerce in connection with the identified services.

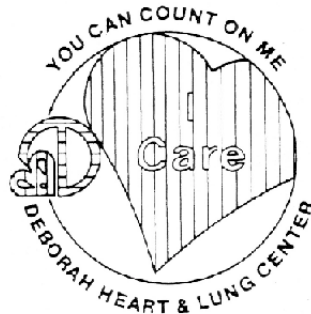
Opposition No. 91154019

(1) Registration No. 1678027, issued March 3, 1992 for the mark DEBORAH DIFFERENCE for "healthcare services; dissemination of information to aid in combating diseases; scientific research for others relating to diseases" in International Class 42; Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed;

(2) Registration No. 1680724, issued March 24, 1992 for the mark DEBORAH for "healthcare services; dissemination of information to aid in combating diseases; scientific research for others relating to diseases" in International Class 42; Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed;

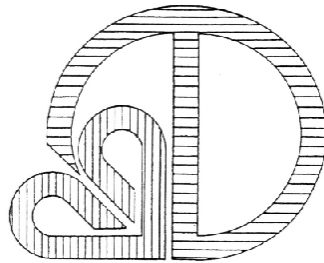
(3) Registration No. 2229230, issued March 2, 1999 for the mark DEBORAH ... THE HEART OF NEW JERSEY for "charitable fund raising services" in International Class 36, and "patient health care services" in International Class 42;

(4) Registration No. 1465813 issued November 27, 1987 for the mark shown below



for "fund raising services for medical research and health care" in International Class 36; the words "heart & lung center" are disclaimed; the mark is lined for the colors red and blue, but color is not claimed as a feature of the mark; the mark comprises a heart design in juxtaposition to a stylized letter 'D'; Section 8 affidavit accepted, Section 15 affidavit acknowledged; and

(5) Registration No. 1322515 issued February 26, 1985 for the mark shown below



for "fund raising services for medical research and health care" in International Class 36; "educational services, namely, conducting seminars/workshops in the field of heart and lung disease" in International Class 41; and "hospital dispensary and clinic health services; disseminating information to aid in combating diseases; and scientific research performed for others relating to diseases" in International Class 42; the mark is lined for the colors red and blue, but color is not claimed as a feature of the mark; the mark comprises a heart design in juxtaposition to a

stylized letter 'D'; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

In its answer applicant admits the following: (i) paragraphs 2(a)-(d) of the opposition, which are allegations that opposer owns the mark DEBORAH, and that opposer owns the first four registrations listed above for the involved services;² (ii) paragraph 5 of the opposition, which include allegations that there is no issue of priority, and that applicant's application filing date is subsequent to the first use of each of opposer's "DEBORAH Marks" as well as the issuance of the "DEBORAH Registrations"; and (iii) paragraph 12 of the opposition to the extent that opposer has no control over the nature and quality of the services in connection with which applicant will use its mark. Applicant otherwise denies the salient allegations of the notice of opposition.³

The record consists of the pleadings; the file of applicant's involved application; the stipulation of the parties (filed October 29, 2003, via certificate of mailing) that the testimony of witnesses may be presented in affidavit form pursuant to Trademark Rule 2.123(b); opposer's affidavit testimony, with exhibits, of Spero

² Applicant did not admit the last two subparagraphs (i.e., paragraphs 2(e)-(f)) presumably due to typographical errors made by opposer, making those two subparagraphs incomplete.

Margeotes, opposer's president and CEO; opposer's notices of reliance on (i) status and title copies of its five pleaded registrations, (ii) the file histories of opposer's five pleaded registrations; and (iii) certain discovery materials (i.e., opposer's first set of interrogatories to applicant, and applicant's responses and follow-up answers thereto); applicant's affidavit testimony, with exhibits, of Thomas J. Browne, applicant's founder and president; and applicant's notice of reliance on certain discovery materials (i.e., opposer's responses to applicant's request for admission Nos. 1, 3, 4, 8, 10, 20 and 21).

Both parties filed briefs on the case,⁴ and both parties were represented at the oral hearing held before the Board on September 21, 2004.

The Parties

Opposer, Deborah Heart and Lung Center, was established in 1922 as a tuberculosis sanitarium and pulmonary center in rural Burlington County, New Jersey, and today it is a 161-bed hospital with a full-service ambulatory care center,

³ Applicant's "affirmative defenses" are more in the nature of further information relating to its denials of opposer's likelihood of confusion claim.

⁴ Opposer resubmitted the evidence originally filed on November 7, 2003 to the Board and, in its brief after trial (p. 6), opposer noted that it was awaiting a decision by the Board on opposer's "petition" that the resubmitted evidence be accorded the original filing date. Such a motion is not necessary in general. In this case, in particular, the papers filed on November 7, 2003 have been located. Accordingly, opposer's "petition" regarding the filing date of the resubmission of its evidence is moot.

specializing in cardiac, vascular and pulmonary medicine and technology. It is a teaching hospital with doctors and nurses coming from around the country and the world to receive training and education. Opposer also participates in educational programs such as community education and health awareness for non-professionals.

The Deborah Hospital Foundation is the fundraising arm of opposer, and the foundation was established in 1974 solely for that purpose. Opposer's medical and fundraising initiatives are inextricably linked, as opposer relies heavily on volunteers, donors and friends to provide resources. The success of its fundraising efforts "has a significant impact on the quantity and quality of charitable care that [opposer] can provide to patients who could not otherwise afford the care." (Margeotes affidavit, paragraph 18.) Any detriment to the success of opposer's fundraising can affect its ability to participate in medical research and quality education as well. (Margeotes affidavit, paragraph 19.)

Since 1972, opposer has operated a "Children of the World®" medical program, which has helped children from the United States and many other countries with their medical and surgical needs.

Doctors throughout the United States and the world refer patients to opposer. In 2002, opposer performed

approximately 200,000 medical procedures, attended to 36,000 ambulatory care cases and admitted over 5,000 patients for an average hospital stay of 6.4 days. Opposer's total expenses for 2002 were \$140 million (about \$90 million of that total allocated to surgical and medical care of patients). Opposer has about 50,000 volunteers and 200 chapters (located primarily on the eastern seaboard from Puerto Rico to Maine).

Opposer has enjoyed extensive media coverage -- local, national, and international, including being the subject of a feature on NBC's TODAY show. New Jersey offers a license plate displaying opposer's service marks; and opposer has won an Aster Award for healthcare marketing.

Opposer has accreditations by and/or memberships in such organizations as the American Medical Association and the Joint Commission on Accreditation of Healthcare Organizations; and it has affiliations with several hospitals and colleges.

Opposer raises funds through a variety of methods, including sending fundraising letters to recipients ranging from individuals to corporations, hosting charity dinners, and via the Internet through the third-party "iGive.com" website.

Opposer is aware of no instances of actual confusion.

Applicant, Deborah Strange-Browne Inflammatory Breast Cancer Foundation, was formed in 2001, receiving its Section 501(c)(3) designation in June 2002. Thomas J. Browne formed the foundation in memory of and after the death of his wife, Deborah Strange-Browne, from inflammatory breast cancer (IBC) for the purposes of helping the medically underserved with IBC, to promote public awareness of this disease, to advance research on IBC, and to educate people about IBC.

Applicant first used the involved mark in connection with its services in 2002 and has continuously used the mark since then. Applicant solicits contributions from a mailing list of family and friends; and it has hosted one fundraising dinner and has another such dinner planned. Applicant targets letters to corporations, and is registered with the "iGive.com" website. In 2002, applicant entered into an "arrangement" (Browne affidavit, paragraph 10) with the Little Company of Mary Hospital (a full service hospital) in Chicago, whereby applicant contributes to fund treatment directly related to IBC.

Applicant is aware of no instances of actual confusion.

Standing

Without doubt, opposer's registrations and the testimony about its activities establish that opposer has standing to bring this opposition. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Priority

Applicant admitted in its answer to the notice of opposition that there is no issue as to priority and that applicant's application was filed subsequent to opposer's first use of each of its marks (paragraph 5).

Likelihood of Confusion

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities of the marks and the similarities of the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Although opposer has relied on five registrations for various DEBORAH marks, in considering the likelihood of

confusion question, we will focus our analysis on opposer's marks DEBORAH for "healthcare services; dissemination of information to aid in combating diseases; scientific research for others relating to diseases," and DEBORAH ... THE HEART OF NEW JERSEY for "charitable fund raising services" and "patient health care services."

Applicant strenuously argues that patients will know which disease they have; seminar attendees will know why they are attending a seminar and the topic thereof; and charitable donors will know to whom they want to give their funds. We acknowledge that the record shows that applicant's foundation focuses only on the disease of inflammatory breast cancer (although not all of applicant's identified services are so limited), and that opposer's focus generally, although not exclusively, relates to heart and lung problems. However, the question before us is not whether consumers/donors would be confused about the services themselves; rather, the question is whether these consumers/donors are likely to be confused about the source of the fundraising and educational services.

Turning first to a consideration of the services, the issue of likelihood of confusion must be determined in light of the services as identified in the involved application and registration(s) and, in the absence of any specific limitations therein, on the presumption that all normal and

usual channels of trade and methods of sale are or may be utilized for such services. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Applicant's identified services are "charitable fundraising services for inflammatory breast cancer research and raising money for community health awareness programs" and "education services, namely, community health awareness programs in the nature of seminars and classes."

Opposer's Registration No. 1680724 is for DEBORAH for, inter alia, "dissemination of information to aid in combating diseases." This service is closely related to applicant's "education services, namely, community health awareness programs in the nature of seminars and classes." Both services involve providing information. Further, applicant's "community health awareness programs in the nature of seminars and classes" could include information on combating diseases, the same information which is identified in opposer's identification. In any event, because both parties provide health information services, the services, must, at a minimum, be considered closely related.

Considering the similarities/dissimilarities of applicant's mark shown below



and opposer's mark DEBORAH, it is well settled that marks must be considered in their entirety because the commercial impression of a mark to an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980).

However, our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more

significance than another. See *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Applicant essentially contends that the marks are fundamentally different; that applicant's composite mark is different in appearance and impression from each of opposer's marks; that the parties' respective marks are different in structure; that there is no dominant feature in applicant's mark, but rather all elements of its mark must be considered together; that the parties pronounce the word "DEBORAH" differently -- applicant's mark is pronounced as two syllables ("deb-ra") and opposer's mark is pronounced as three syllables ("deb-OR-ah"); and that the distinct purpose of applicant's foundation is part of applicant's mark itself.

Opposer essentially contends that DEBORAH is the dominant feature of applicant's mark, with the words "inflammatory breast cancer foundation" disclaimed, and the stylized letter "d" representing the first word DEBORAH; that the American public often abbreviates names to use nicknames, thus emphasizing the word DEBORAH in applicant's mark; that while there is a surname in applicant's mark, there is no surname in opposer's DEBORAH marks, such that consumers could think the DEBORAH in each mark refers to the

same person; and that potential customers/donors of the parties' educational and fundraising services are likely to perceive applicant's mark as being a variation of opposer's DEBORAH marks.

Obviously, as asserted by applicant, its mark consists of seven words, in differing fonts, with an underline and a stylized letter "d." There are clearly differences between the applicant's mark and opposer's mark DEBORAH. However, there is no question that the word DEBORAH is the most prominent word in applicant's mark, and that the word is emphasized by the stylized letter "d," the initial for the name DEBORAH. The remaining elements in applicant's mark are depicted in much smaller type. Thus, the word DEBORAH is the most memorable feature of applicant's mark. Although the stylized letter "d" is prominently depicted, it is the name DEBORAH which is likely to be pronounced and therefore remembered. See *In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Applicant's argument regarding the parties' different pronunciations of the word DEBORAH is unpersuasive. Even if the parties actually pronounce the word DEBORAH in different ways, the public may not do so. Further, there is no "correct" pronunciation of a trademark. See *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969); *Interlego v.*

Abrams/Gentile Entertainment Inc., 63 USPQ2d 1862 (TTAB 2002); and In re Lamson Oil Co., 6 USPQ2d 1041 (TTAB 1987). Because the words are spelled the same, they are likely to be pronounced the same by at least some number of consumers.

Overall, applicant's mark and opposer's mark DEBORAH convey the same commercial impression. As noted, applicant's mark clearly emphasizes the word DEBORAH, which is the entirety of opposer's mark. The name DEBORAH in applicant's mark and in opposer's mark is the same -- that of a female given name. Although applicant's mark contains additional design elements and generic words which relate to the specific disease covered by applicant's foundation, consumers who are familiar with opposer's services are likely to believe that applicant's services emanate from or are associated with the same source.

With respect to opposer's Registration No. 2229230 for DEBORAH ... THE HEART OF NEW JERSEY for "charitable fundraising services," these services are legally identical to applicant's "charitable fundraising services for inflammatory breast cancer research," because they encompass the more limited or specific services in applicant's identification. Our primary reviewing Court has stated that "when marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." See

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Although opposer's mark DEBORAH ... THE HEART OF NEW JERSEY includes additional wording, the dominant feature remains the word DEBORAH. The differences between this mark and applicant's mark are not sufficient to avoid a likelihood of confusion.

There are no restrictions or limitations on trade channels or purchasers/donors in the parties' above-discussed identified services. Therefore, we must presume in this administrative proceeding that the parties' involved services are offered through all normal channels of trade to all usual classes of purchasers/donors for such services. See Octocom Systems Inc. v. Houston Computers Services Inc., supra; and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, supra. In fact, here there is evidence that both parties engage in fundraising under the involved marks through the same third-party -- the "iGive.com" website.

Looking next at the du Pont factor of the fame of opposer's marks, opposer argues that its DEBORAH mark is a strong trademark that has acquired regional, national and international renown over the course of eighty years. Applicant stated the following with regard to the strength of opposer's marks: "Applicant has never contended that Opposer's mark, or marks are not strong. This has not been an issue, nor should it be." (Brief, p. 19.) The record

herein clearly supports a finding that opposer's DEBORAH mark is well known or renowned for its healthcare services. However, we do not find the evidence in this record adequate to persuade us that opposer's mark DEBORAH is well known for fundraising services and/or for educational services (dissemination of information regarding combating diseases). Thus, we will accord opposer's DEBORAH mark only the normal scope of protection otherwise afforded to registered marks.

Neither applicant nor opposer is aware of any instances of actual confusion. However, applicant's use only commenced in 2002, so there has been very little time of overlap of use of the respective marks of these parties. That is to say, the absence of evidence of actual confusion is offset by the absence of evidence that there has been a substantial opportunity for confusion to have occurred. In these circumstances, we cannot conclude that the apparent absence of actual confusion is entitled to significant legal weight in the likelihood-of-confusion analysis. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902, F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Applicant's argument that it adopted its mark in good faith is similarly unavailing. Although an intent to trade on the mark of another is strong evidence of likelihood of confusion because it is presumed that such an intention is successful, the converse is not true. That is, good faith adoption does not necessarily mean that confusion is not likely. Stated another way, that applicant did not intend to cause confusion by adopting a similar mark in connection with virtually identical and closely related services does not justify registration if confusion is likely to occur. See *Hydra Mac, Inc. v. Mack Trucks, Inc.*, 507 F.2d 1399, 184 USPQ 351 (CCPA 1975); and *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988). See also, *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion. (citation omitted).")

On balance, considering all of the evidence on the relevant du Pont factors, and giving each such factor its appropriate weight in the circumstances of this case, we find that confusion is likely between applicant's mark (as shown above) and opposer's marks DEBORAH and DEBORAH ... THE HEART OF NEW JERSEY when used in connection with these

similar and closely related services. See *Cunningham v. Laser Golf Corp.*, supra.

In view of our finding, we need not address the question of likelihood of confusion with respect to opposer's other pleaded registrations. Nor do we need to address the claims brought by opposer based on its common law rights.

Decision: The opposition is sustained and registration to applicant is refused.